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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONWAY ROBERT SHAW, GUY ARTHUR DURHAM,
NIGEL DAVID TOUT, ARNOLD GOCOOL, SEAN PRIOR,
ELIE ABI CHAAYA, and GUY ALEXANDER HOOKER

Appeal 2008-0524
Application 09/074,093
Technology Center 2600

Decided: June 26, 2008

Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-27. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants invented a portable radio telephone. Specifically, the telephone has an antenna that pivots in only a single plane, pivots through an acute angle, biases toward stable positions, and locks into position. The antenna projects from the surface of the telephone in both a first position and a second position in order to provide a better radiation pattern and reception for the antenna.¹ Claim 1 is illustrative:

1. A portable radio telephone having an antenna which can be pivoted about an axis between a first position in which it projects from a surface of the telephone, and a second position in which it projects from a surface of the telephone, whereby the antenna may only pivot in a single plane and through an acute angle, the antenna being biased and adapted to be locked as the antenna pivots.

The Examiner relies on the following prior art references to show unpatentability:

Rydbeck	US 5,590,416	Dec. 31, 1996
Podgorny	GB 2 018 033 A	Oct. 10, 1979

The Examiner's rejection is:

Claims 1-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rydbeck and Podgorny.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs² and the Answer³ for their respective details. In this

¹ See generally Spec. 1:28 – 2:20 and 6:26 – 7:27.

² We refer to the Appeal Brief filed February 12, 2002, and the Reply Brief filed April 25, 2002, throughout this opinion.

decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Discussing the question of obviousness of a patent that claims a combination of known elements, the U.S. Supreme Court explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida [v. AG Pro, Inc.]*, 425 U.S. 273 (1976) and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.]*, 396 U.S. 57 (1969) are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR Int'l v. Teleflex, Inc., 127 S. Ct. 1727, 1740 (2007). If the claimed subject matter cannot be fairly characterized as involving the simple

³ We refer to the most recent Examiner's Answer mailed October 22, 2003, throughout this opinion.

substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements in the fashion claimed.” *Id.* at 1741. Such a showing requires,

‘some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *Id.* at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

If the Examiner’s burden is met, the burden then shifts to the Appellants to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Appellants group the arguments according to the following claims: (1) 1-17; (2) 18-20; (3) 21-22; (4) 23-26; and (5) 27 (App. Br. 5-6). Below, each group will be addressed.

Claims 1-17

Regarding independent representative claim 1,⁴ the Examiner’s rejection essentially finds that Rydbeck discloses all the features recited in claim 1, except for the limitations that the antenna: (1) may only pivot in a single plane; (2) is biased; and (3) is adapted to be locked as the antenna

⁴ Appellants argue claims 1-17 as a group (App. Br. 6-12). Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

pivots (Ans. 4). The Examiner cites Podgorny to teach these missing limitations. In view of Podgorny's teachings, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to include the features of the antenna of Podgorny into Rydbeck's antenna in order to provide greater simplicity and to improve the antenna movement of Rydbeck (Ans. 5). Appellants argue: (1) Rydbeck does not disclose an antenna that is biased and adapted to be locked as the antenna pivots; (2) Rydbeck's design could damage the antenna when a downward force is applied and does not permit single handed operation; (3) the Examiner has improperly relied on hindsight to formulate the obviousness rejection; and (4) the prior art fails to disclose all the limitations in claim 1 (App. Br. 8-12).

The issue before us is whether Appellants have shown that the Examiner erred in finding that the combination of Rydbeck and Podgorny discloses or teaches the limitations recited in claim 1. For the following reasons, we find that no such error has been shown.

Rydbeck discloses a portable radio telephone with an antenna that pivots about an axis between a first and second position in order to reduce the electromagnetic shielding caused by the user's head (Rydbeck, col. 1, ll. 56-67 and col. 3, l. 62 – col. 4, l. 14; Figs. 1-3). The antenna pivots in multiple planes and through an acute angle (Rydbeck, col. 4, l. 15 - col. 5, l. 16; Figs. 1-2). Rydbeck does not disclose the antenna is biased or adapted to be locked as the antenna pivots (Ans. 4). Rydbeck further discusses that "other conventional mountings which allow the antenna to move between first and second positions may be used as will be understood by those having skill in the art" (Rydbeck, col. 5, ll. 16-19). Thus, Rydbeck suggests to

those skilled in the art that other mechanisms for mounting the antenna to the portable telephone can be substituted for the disclosed mounting.

Podgorny teaches such other conventional mechanisms for mounting an antenna to a portable radio known by those skilled in the art to allow an antenna to move between a first and second position (Podgorny 1:6-45). Similar to Rydbeck, this arrangement improves the quality of the reception by permitting the antenna's orientation to be changed in space (Podgorny 1:12-24). Each embodiment in Podgorny pivots the antenna in only a single plane, biases the antenna through a spring 13 and adjustable screw 14, and adapts the antenna to be locked through the recesses 9 and projections 8 of the base 3, locking members 11 and separating member 12. *See, e.g.,* Podgorny, 1:25-45 and 2:96-3:4. Such an arrangement provides for simplified manufacturing and assembly (Podgorny 2:7-14). As such, we find that one skilled in the art would have been motivated to substitute the antenna mounting mechanism disclosed by Podgorny that only pivots in a single plane for the mounting device of Rydbeck in order to improve Rydbeck in a similar manner with a simpler device to make and assemble. Additionally, one skilled in the art would have recognized that including the biasing and lockable features of Podgorny would improve the Rydbeck device in the same way by providing increased stability and firmness to the antenna (Podgorny 4:34-56). Finally, in order to maintain the feature of Rydbeck's antenna of pivoting through the acute angle as shown in Figures 1 through 3, one skilled in the art would have known to include the appropriate number of projections and recesses on the base of the antenna.

Based on the above discussion, we find no error in the Examiner's combination of Rydbeck and Podgorny as teaching all the limitations found

in claim 1. We also find no error in combining these respective teachings as we find ample rationale on this record for such a combination. The Examiner has, therefore, not relied on hindsight or Appellants' disclosure in formulating the obviousness rejection of claim 1.

Appellants argue Rydbeck does not disclose an antenna that is biased and adapted to be locked as the antenna pivots (App. Br. 8). We find this argument unpersuasive. First, the Examiner concedes that Rydbeck does not disclose this feature (Ans. 4, 8). Second, as discussed above, Podgorny teaches these claim limitations (Podgorny 1:25-45 and 2:96-3:4). Third, as also discussed above, the cited prior art provides ample rationale for combining their respective teachings to arrive at an antenna that is biased and adapted to be locked as the antenna pivots as claimed.

Appellants also dispute that Rydbeck's design could damage the antenna when a downward force is applied and does not permit single handed operation (App. Br. 8). We are also not persuaded by this argument because these features are not commensurate with the scope of claim 1.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of representative independent claim 1 based on the collective teachings of Rydbeck and Podgorny. Accordingly, we will sustain the Examiner's rejection of claim 1 and claims 2-17 which fall with claim 1.

Claims 18-20

Representative independent claim 18⁵ recites a portable telephone having similar features to claim 1 and additionally including an antenna that is non-retracting. The antenna in claim 18 is arranged to pivot in a single plane rather than only in a single plane. For claim 18, the Examiner essentially uses the same ground of rejection as claim 1 (Ans. 4-5) and that discussion is incorporated by reference. Appellants repeat the arguments made with respect to claim 1 (App. Br. 12-13). We therefore incorporate our previous discussion of claim 1 regarding what Rydbeck and Podgorny teach and the reasonable rationale for combining their teachings.

For the above stated reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of representative independent claim 18 based on the collective teachings of Rydbeck and Podgorny. Accordingly, we will sustain the Examiner's rejection of claim 18 and claims 19 and 20 which fall with claim 18.

Claims 21 and 22

Representative independent claim 21⁶ recites a portable radio telephone having the same features as claim 1 and additionally includes the feature of an antenna that can pivot about an axis arranged internally of the telephone between a first and second position. For claim 21, the Examiner essentially uses the same ground of rejection as claim 1 (Ans. 4-5) and that

⁵ Appellants argue claims 18-20 as a group (App. Br. 12-13). Accordingly, we select claim 18 as representative. See 37 C.F.R. § 41.37(c)(1)(vii).

⁶ Appellants argue claims 21 and 22 as a group (App. Br. 13). Accordingly, we select claim 21 as representative. See 37 C.F.R. § 41.37(c)(1)(vii).

discussion is incorporated by reference. Appellants repeat the arguments made with respect to claim 1 (App. Br. 13).

We incorporate our previous discussion of claim 1 regarding what Rydbeck and Podgorny teach and the reasonable rationale for combining their teachings. Additionally, Podgorny teaches the axis about which the antenna pivots is arranged internally of or encased in the portable radio housing (Podgorny 1:25-27; Figs. 1-3, 11-13, 15, 18, and 19). For the reasons previously stated, including improving the stability and firmness to the antenna, one skilled in the art would have been motivated to include an antenna which can be pivoted about an axis arranged internally of the Rydbeck telephone between a first and second position. Moreover, such a modification would not destroy or render the Rydbeck device inoperable.

For the above stated reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of representative independent claim 21 based on the collective teachings of Rydbeck and Podgorny. Accordingly, we will sustain the Examiner's rejection of claim 21 and claim 22 which falls with claim 21.

Claims 23-26

Claims 23-26 recite various features regarding the antenna being biased, releasably locked, and stable in a canted and/or upright position. The Examiner cites Podgorny to teach these missing limitations (Ans. 6). In view of Podgorny's teachings, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to include the features of the antenna of Podgorny into Rydbeck's antenna

(Ans. 6, 9-10). Appellants dispute the prior art discloses the claimed elements in claims 23 through 26 (App. Br. 13-14).

Apart from merely asserting that these limitations are not found in Rydbeck or Podgorny, Appellants do not specifically address the Examiner's specific positions articulated in the Answer or explain why these positions are deficient. Merely pointing out what a claim recites is not considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). In any event, such conclusory statements fall well short of rebutting the Examiner's prima facie case of obviousness articulated in the rejection – a position that we find reasonable.

For the above stated reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of claims 23-26 based on the collective teachings of Rydbeck and Podgorny. Accordingly, we will sustain the Examiner's rejection of claim 23-26.

Claim 27

Independent claim 27 recites a portable radio telephone having the features in claim 1 excluding the limitation of the antenna pivoting through an acute angle. For claim 27, the Examiner essentially uses the same ground of rejection as claim 1 (Ans. 4-5) and that discussion is incorporated by reference. Appellants dispute the prior art discloses the claimed elements in claim 27 (App. Br. 14-15).

Apart from merely asserting that these limitations are not found in Rydbeck or Podgorny, Appellants do not specifically address the Examiner's specific positions articulated in the Answer or explain why these positions are deficient (App. Br. 14). Merely pointing out what a claim recites is not

considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). In any event, such conclusory statements fall well short of rebutting the Examiner's prima facie case of obviousness articulated in the rejection – a position that we find reasonable. Additionally, we incorporate our previous discussion of claim 1 regarding what Rydbeck and Podgorny teach and the reasonable rationale for combining their teachings.

For the above stated reasons, Appellants have not shown error in the Examiner's obviousness rejection of independent claim 27 based on the collective teachings of Rydbeck and Podgorny. According, we will sustain the Examiner's rejection of claim 27.

DECISION

We have sustained the Examiner's rejection of all claims on appeal. Accordingly, the decision of the Examiner to reject claims 1-27 is affirmed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2008-0524
Application 09/074,093

AFFIRMED

gvw

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